

REMARKS

STATUS OF THE CLAIMS

Claims 1-28 and 30-53 are pending as shown in the paper mailed May 19, 2005. Claims 1, 3, 5, 7-9, 11-21, 23, 24, 33-35, 38 and 42-52 have been withdrawn from consideration and claims 2, 4, 6, 10, 22, 25-28, 30-32, 36, 37, 39-41 and 53 are under consideration.

REJECTIONS WITHDRAWN

Applicants note that the rejections under 35 U.S.C. §§ 112, 2nd paragraph; 102(b); 102(e) and 103(a) have all been withdrawn.

INFORMATION DISCLOSURE STATEMENT

Applicants submit herewith an IDS pursuant to 37 C.F.R. §1.97(d), including the statement specified in 37 C.F.R. § 1.97(e).

Applicants acknowledge consideration of the references provided with the Information Disclosure Statements received in the USPTO on May 11, 2005 and September 1, 2005.

RESTRICTION/ELECTION

The Examiner asserts that claim 30 is not a linking claim as between Groups I, II and III on the grounds that "Group II is drawn to a polynucleotide, Group I is drawn to an isolated protein, and Group III is drawn to a method of using the polynucleotide of Group II and does not use the protein of Group I as claimed." (Final Office Action, sentence bridging pages 2-3).

Applicants reiterate that claims 3, 5, 7-9, 11-21, 23, 24, 34, 35 and 38 will be considered upon allowance of a generic claim 30. Furthermore, Applicants reiterate their request for rejoinder of claims 42-51, which method claims contain all the limitations of the independent claim 30 (Group II). Applicants also maintain traverse, and reserve their right to petition the finality of the Restriction Requirement.

35 U.S.C. § 112, 1ST PARAGRAPH, WRITTEN DESCRIPTION

Claims 2, 4, 6, 10, 22, 25-28, 30-32, 36, 37, 39-41 and 53 were rejected under 35 U.S.C. § 112, 1st paragraph as allegedly not described by the specification as filed in such a way as to reasonably convey to one skilled in the relevant art that the inventors were in

possession of the claimed subject matter. (Final Office Action, pages 3-8). In particular, it was alleged that the specification does not adequately describe the structure of non-canonical zinc finger proteins (other than C2HC fingers). *Id.*

Because the specification as filed literally describes (and thus evinces possession of) each and every member of the claimed genus, Applicants traverse the rejection.

The specification as filed provides literal description of every possible representative species, including, for example on page 4, lines 6-14; page 7, line 19 to page 8, line 5; and page 19, line 14 to page 20, line 15, where the complete structure of all the molecules falling within the scope of the claims is set forth. From this clear description, the skilled artisan would know which amino acids could be at each residue of the claimed molecule and, accordingly, would be aware that Applicants were in possession of every molecule of the claimed genus. Therefore, the as-filed specification satisfies the written description requirement.

What the Examiner appears to be requiring is that Applicants' specification actually list out particular amino acid residues in each position (X, B, Z and/or Y) of the molecule recited in the claims. Such a listing requirement is not and has never been what is needed in order to satisfy the written description requirement of 35 U.S.C. § 112, 1st paragraph. Indeed, the written description inquiry is dependent on the particular fact pattern (disclosure, state of the art, etc.), with the underlying assumption that the specification as filed is presumed to satisfy the written description requirement. Moreover, listing of multiple embodiments has never been a requirement of 35 U.S.C. § 112, first paragraph and, in fact, the Federal Circuit, the Board, the M.P.E.P. and the PTO's own Training Materials forbid such a test.¹ *See, also, In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

Further, the Examiner has ignored the well-established rule that an applicant need not describe and preferably omits that which is not new. As set forth in the recent case of *Capon v. Eshhar* 76 USPQ2d 1078 (Fed. Cir. 2005), the Federal Circuit completely rejects the notion that the specification must describe information that is either known or can readily be determined based on scientific facts (*Capon* at page 1085, emphasis added):

¹ Indeed, as the Examples of PTO Training Materials on Written Description, including Example 14: "Product by Function," make clear, disclosure of a single species can readily satisfy the written description requirement for broad claims.

The "written description" requirement must be applied in the context of the particular invention and the state of the knowledge. The Board's rule that the nucleotide sequences of the chimeric genes must be fully presented, although the nucleotide sequences of the component DNA are known, is an inappropriate generalization. ...

The "written description" requirement states that the patentee must describe the invention; it does not state that every invention must be described in the same way. As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.

As in *Capon*, the Examiner's assertion in the instant case that Applicants are required to disclose the precise sequence of multiple non-canonical zinc fingers as set forth in the claims, is inappropriate. A skilled artisan could readily chose any of the twenty known amino acids for X, any of the nineteen known amino acids excluding cysteine for B, any of the nineteen known amino acids excluding histidine for Z and any of the eighteen known amino acids excluding histidine or cysteine for Y. Thus, a skilled artisan could readily make the amino acid replacements that are literally described in the specification, and, accordingly, the written description requirement is met.

In sum, it is legal and factual error to assert that the skilled artisan reading the specification would not have understood that Applicants described every member of the genus. Accordingly, the rejection under 35 U.S.C. § 112, first paragraph, written description, should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants submit that the claims are in condition for allowance.

Respectfully submitted,

Date: December 5, 2005

By: _____



Dahna S. Pasternak

Reg. No. 41,411

Attorney for Applicants

ROBINS & PASTERNAK LLP
1731 Embarcadero Road
Suite 230
Palo Alto, CA 94303
Tel.: (650) 493-3400
Fax: (650) 493-3440